



# Canadian Intellectual Property Office

## **THE REGISTRAR OF TRADEMARKS**

**Citation:** 2022 TMOB 254

**Date of Decision:** 2022-12-16

## **IN THE MATTER OF AN OPPOSITION**

**Opponent:** 1000 Islands Brewery Inc.

**Applicant:** Edward Byers

**Application:** 1809513 for Thousand Islands River Brewing Company

### **INTRODUCTION**

[1] 1000 Islands Brewery Inc. (the Opponent) opposes registration of the trademark Thousand Islands River Brewing Company (the Mark), which is the subject of application No. 1,809,513 (the Application), that was filed by Edward Byers (the Applicant).

[2] The Application was filed on November 15, 2016, on the basis of proposed use in Canada in association with the statement of goods as reproduced below, together with the associated Nice class (CI):

CI 9 (1) Neon signs.

CI 16 (2) Advertising signs of paper; posters.

CI 21 (3) Bottle openers; drinking glasses.

CI 25 (4) Promotional caps; promotional t-shirts.

CI 28 (5) Golf balls.

CI 32 (6) Beer, ale, lager, stout and porter.

[3] The Application was advertised in the *Trademarks Journal* of August 1, 2018. On January 2, 2019, the Opponent filed a statement of opposition against the Application pursuant to section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). Numerous amendments to the Act came into force on June 17, 2019. However, as the Application in this case was advertised before June 17, 2019, pursuant to section 70 of the Act, the grounds of opposition will be assessed based on the Act as it read on June 16, 2019.

[4] The statement of opposition raised grounds of opposition based non-compliance with sections 30(a), 30(e), and 30(i), and non-distinctiveness under section 2 of the Act.

[5] On March 14, 2019, the Applicant requested an interlocutory ruling on the sufficiency of the Opponent's pleadings. The interlocutory ruling was issued on April 18, 2019, and struck each of the grounds of opposition based on non-compliance in their entirety (sections 30(a), 30(e), and 30(i)), as well as partially struck the remaining ground of opposition based on non-distinctiveness, as will be discussed below.

[6] The Applicant filed and served its counter statement on May 19, 2021, denying the remaining ground of opposition.

[7] In support of its opposition, the Opponent filed the affidavit of D. Jill Roberts, sworn December 2, 2019, together with Exhibit A.

[8] In support of its Application, the Applicant filed a certified copy of the file wrapper for the trademark BRASSERIE MILLE ILES BREWERY & DESIGN, application No. 1,810,725.

[9] Neither party filed written representations; however, both parties made representations at a hearing.

[10] For the reasons that follow, I reject the opposition.

## **EVIDENCE SUMMARY**

### ***Opponent's Evidence – Roberts Affidavit***

[11] Ms. Roberts, a law clerk, attests that she accessed the Canadian Intellectual Property Office Trademarks Database on December 2, 2019, and conducted a search for trademark application No. 1,810,725. She attaches, as Exhibit A to her affidavit, a printout of this trademark application.

[12] The trademark application referred to in Exhibit A is for the trademark BRASSERIE MILLE ILES BREWERY & Design, filed on November 22, 2016, seven days after the filing of the Application, and is also based on proposed use in association with the goods: dessous de chopes à bières; chopes à bières; pots à bière; verres à bière; casquettes promotionnelles; chandails; t-shirts promotionnels; bières; and with the services: brasserie. The applicant of this trademark application is 9714235 Canada Inc.

### ***Applicant's Evidence – Certified Copy of File Wrapper of Application No. 1,810,725 for the trademark BRASSERIE MILLE ILES BREWERY & Design***

[13] The Applicant refers to this application as the Opponent's trademark, although the applicant listed on the application is 9714235 Canada Inc., which differs from the present Opponent (1000 Islands Brewery Inc.). Any relationship between 9714235 Canada Inc. and the Opponent, 1000 Islands Brewery Inc., is not established in the file wrapper.

[14] The file wrapper includes correspondence during the prosecution of this application, which included amongst other objections made by the Registrar, an objection to registration based on confusion with the current Application.

## **ANALYSIS**

### **Section 2 Ground of Opposition**

[15] This ground of opposition, identified as paragraph 3(d) in the statement of opposition, was partially struck in the interlocutory ruling of April 18, 2019. The ground as restricted now reads as follows:

The trademark claimed in the application is not distinctive nor is it adapted to distinguish the wares in association with which it is proposed to be used by the Applicant from:

- The beer of the opponent sold and advertised in Canada in association with the trademarks expressly pleaded in paragraph 3(d) of the statement of opposition, namely the trademarks THOUSAND ISLANDS and 1000 ISLANDS;
- The wares/services of Brasserie Mille Iles Brewery (identified by the opponent at paragraph 3(d) of the statement of opposition as “making and selling beer in Canada”) in association with the trademark MILLE ILES.

[16] There is an initial evidentiary burden on the Opponent to establish the facts relied upon in support of its non-distinctiveness ground. Once the burden has been met, there is a legal onus on the Applicant to show that the Mark is adapted to distinguish or actually distinguishes its goods and services from those of others [see *Labatt Brewing Company Limited v Molson Breweries, a Partnership* (1996), 1996 CanLII 17947 (FC), 68 CPR (3d) 216 (FCTD) at 298; *Muffin Houses Incorporated v The Muffin House Bakery Ltd*, (1985) 4 CPR (3d) 272 (TMOB); *Imperial Tobacco Canada Limited v Philip Morris Products SA*, 2013 TMOB 175 at para 24, aff'd 2014 FC 1237 at paras 15-16 and 68; and *JTI-Macdonald TM Corp v Imperial Tobacco Products Limited*, 2013 FC 608 at para 55].

[17] This means that in order to meet its initial burden under this ground, the Opponent must establish that as of the filing date of the statement of opposition, namely, January 2, 2019 one or more of the trademarks relied upon by the Opponent (THOUSAND ISLANDS, 1000 ISLANDS, and MILLES ILES) had become known sufficiently in association with the recited alleged goods and services, to negate the distinctiveness of the Mark, and that the reputation of one or more of these trademarks in Canada was substantial, significant or sufficient [see *Bojangles' International LLC v Bojangles Café Ltd*, 2006 FC 657 (CanLII), 48 CPR (4th) 427; *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, (2004), 2004 FC 1185 (CanLII), 34 CPR (4th) 317 (FC); and *Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 at 58 (FCTD)].

[18] The Opponent's evidence consists merely of a printout of trademark application No. 1,810,725, as located in the Canadian Intellectual Property Office Trademarks Database on December 2, 2019. There is no evidence of use, promotion, or any other matter that would demonstrate the extent to which any of the Opponent's relied upon trademarks would have become known as of the filing of the statement of opposition. Furthermore, with respect to the allegations that the Opponent has extensively sold and advertised its beer in Canada in association with its trademarks THOUSAND ISLANDS and 1000 ISLANDS, the Opponent has

not filed any evidence in support. Lastly, the Opponent has also failed to file any evidence that Brasserie Mille Iles Brewery has made and sold beer in Canada in association with the trademark MILLE ILES, let alone any evidence that otherwise would speak to the extent that this trademark has been made known in Canada.

[19] At the hearing, the agent for the Opponent argued that as Trademarks Examiners conduct Internet research in the course of examining trademark applications for registration, the Registrar can also take judicial notice and conduct Internet research during the course of an opposition proceeding to determine whether or not pleaded trademarks are being used. Further, the agent for the Opponent argued that the burden on an opponent as established in *Bojangles, supra*, is not significant, and that the Opponent has met this burden by identifying a third party application whose use could then be verified by the Registrar during an Internet search.

[20] The agent for the Applicant correctly responded that the Opponent must provide evidence sufficient to meet its initial evidential burden (or rely on evidence otherwise of record). The Opposition Board does not conduct its own investigation into alleged use of third party trademarks. There is no provision in the Act or *Trademarks Regulations* for it to do so, and indeed doing so would be contrary to the well-established jurisprudence relating to the parties' respective burdens, discussed above.

[21] Indeed, what the agent for the Opponent is proposing, is tantamount to the Registrar conducting research, collecting, and identifying evidence in order to build the Opponent's own case. The Registrar does not have the authority to do so. Judicial notice is not a mechanism with which an Opponent can usurp what they ought to have introduced as evidence themselves, particularly insofar as meeting its burden to establish that one or more of the trademarks relied upon under this ground meets the threshold of being sufficiently known established in *Bojangles, supra*. Furthermore, as to what material Examiners consider in the course of examining files for registration is not a relevant consideration as to the exercise of judicial notice in opposition proceedings.

[22] Consequently, the ground of opposition based on non-distinctiveness is rejected, as the Opponent has failed to meet its initial evidential burden.

**DISPOSITION**

[23] Having regard to the aforementioned, pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(12) of the Act.

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Kathryn Barnett  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

# Appearances and Agents of Record

**HEARING DATE:** 2022-12-13

## **APPEARANCES**

**For the Opponent:** Andrew Jarzyna

**For the Applicant:** Lorraine Pinsent

## **AGENTS OF RECORD**

**For the Opponent:** Moffat & Co.

**For the Applicant:** MLT Aikins LLP